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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215100
Party	Plaintiff Emilio Pucci International BV
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Date	04/30/2015
Attachments	4-30-15 Opposer's Motion to Strike Applicant's Affirmative Defenses.pdf(306671 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EMILIO PUCCI INTERNATIONAL BV,  Opposer,  v.  RANI SACHDEV,  Applicant.	Opposition No.: 91215100  Serial No.: 85913782 Mark: ST. PUCCHI Filing Date: April 24, 2013
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**OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES**

Pursuant to Federal Rule of Civil Procedure 12(f) and Section 506 of the Trademark Trial and Appeal Board Manual of Procedure, Emilio Pucci International BV ("Opposer") moves to strike the affirmative defenses in Applicant's Answer to Notice of Opposition.

**I. INTRODUCTION**

The Board may, upon motion or its own initiative, strike "any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." TBMP § 506; Fed. R. Civ. P. 12(f). Affirmative defenses "should include enough detail to give the plaintiff fair notice of the basis for the defense. TBMP § 311.02(b). In addition, the Board "will not entertain a defense attacking the validity" of a pleaded registration, unless the defendant timely files a counterclaim or petitions to cancel the registration. *Id.*

By this Motion, Opposer moves to strike Applicant's First, Second, Third, Fourth, Fifth, Sixth, Seventh, Eighth, and Ninth affirmative defenses for the reasons detailed below. Striking these defenses allows the Board to streamline this action to the relevant and sufficiently plead claims and affirmative defenses, thereby promoting the interests of judicial economy.

## **II. ARGUMENT**

### **A. The Board Has Discretion to Consider This Motion**

Opposer initiated this proceeding on February 25, 2014. Throughout the last year, Opposer has made repeated good faith efforts to resolve this matter with counsel for Applicant. Counsel for Applicant, on the other hand, has repeatedly attributed his failures to timely respond to Opposer's inquiries and communications to health issues. Counsel for Opposer has been extremely tolerant of these repeated delays in the hope that the parties could reach an amicable resolution.

Given the passage of time and lack of substantive progress in negotiations, Opposer is no longer optimistic about the possibility of settlement. Accordingly, Opposer files this Motion to Strike in recognition of the need to prosecute this action through conclusion and in an effort to simplify and streamline the issues before the Board.

Because the Board may act *on its own initiative* in striking matter from pleadings, it may exercise discretion in considering this motion to strike Applicant's affirmative defenses. Fed. R. Civ. P. 12(f); TBMP § 506.02 (Board has discretion to consider untimely motions filed more than 21 days after service of the pleading at

issue). Opposer respectfully requests the Board's assistance in simplifying the issues open for decision in this case.

**A. Applicant's First, Second and Third Affirmative Defenses Should Be Striken as Insufficient and as Improper Attacks on the Validity of Opposer's Registrations**

Affirmative defenses must include sufficient detail to "give the plaintiff fair notice of the basis for the defense." TBMP § 311.02(b). The Board also will not entertain defenses attacking the validity of a pleaded registration unless the defendant timely files a counterclaim or separate petition to cancel the registration(s). *Id.*; *Nasalok Coating Corp. v. Nylok Corp.*, 86 USPQ2d 1369, 1373 n.3 (in TTAB cases, claims relating to the validity of a pleaded registration are compulsory counterclaims).

Applicant's First Affirmative Defense alleges that "Opposer has failed to adequately maintain, police or enforce any trademark or proprietary rights it may once have had in its alleged trademarks." While unclear from the defense itself, Applicant apparently attempts to assert an abandonment or laches/acquiescence defense. As discussed below, such defenses should be striken either as improper collateral attacks on Opposer's pleaded registrations or as immaterial.

In its Second Affirmative Defense, Applicant alleges that "Opposer's pleaded marks are not inherently distinctive such that purchasers do not associate such marks with Opposer." Again, while Applicant does not state its grounds for doing so with sufficient clarity, it apparently challenges the validity of Opposer's registrations in some way.

Applicant has neither filed counterclaims in this opposition nor petitioned to cancel any of Opposer's pleaded registrations. Because Applicant improperly

challenges the validity of Opposer's registrations in these affirmative defenses and does not adequately state its reasons for doing so, Applicant's First and Second affirmative defenses should be stricken. Applicant's Third affirmative defense of abandonment should similarly be stricken, as it too improperly challenges the validity of Opposer's registrations.

**B. Applicant's Sixth, Seventh, and Eighth Affirmative Defenses Should Be Stricken as Immaterial**

In its Sixth, Seventh, and Eighth affirmative defenses, Applicant asserts defenses of acquiescence, laches, and estoppel, respectively. Board precedent along with the TBMP recognize that such defenses are "severely limited" in opposition proceedings, as each start to run from the time a mark is published for opposition, and not (as in infringement actions) from the time of knowledge of use. TBMP § 311.02(b); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in an opposition proceeding); *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (laches defense "could not possibly start" until application published for opposition); *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 USPQ2d 1789, 1797-98 (TTAB 2009) (estoppel defense must be tied to the registration of applicant's mark, not use); *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005) (acquiescence does not begin to run until the mark is published for opposition).

Here, Opposer duly and timely filed its Notice of Opposition after requesting a ninety-day extension of time pursuant to 37 CFR § 2.102. The short time period (four months) between the publication of the application at issue and the filing of this

opposition is insufficient to constitute an unreasonable delay for purposes of laches, acquiescence, or estoppel. See, e.g., *Panda Travel Inc.*, 94 USPQ2d at 1797-98 (no delay for purposes of laches or estoppel when opposer timely filed its notices of opposition); *Callaway Vineyard & Winery v. Endsley Capital Group Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) (no basis for laches, estoppel, or acquiescence when opposer promptly opposed registration of applicant's mark). Accordingly, Applicant's Sixth through Eighth affirmative defenses of laches, acquiescence, and estoppel should therefore be stricken as immaterial.

**C. Applicant's Fourth, Fifth, and Ninth Affirmative Defenses Should Be Stricken as Redundant**

The Board may strike affirmative defenses as redundant if they do nothing more than restate a denial in the answer and do not add anything to such denials. See *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Applicant's Fourth and Fifth affirmative defenses allege that there is no likelihood of confusion and no actual confusion, respectively. These affirmative defenses do nothing more than restate Applicant's previous denial of Paragraph 24 of the Notice of Opposition. Similarly, Applicant's Ninth affirmative defense—differences in goods, trade channels, and target consumers—merely restates Applicant's denial of Paragraph 22 of the Notice of Opposition. In view of the foregoing, Applicant's Fourth, Fifth, and Ninth affirmative defenses should therefore be stricken as redundant.

### III. CONCLUSION

In the interest of efficiency, and for the reasons discussed above, Opposer respectfully requests that the Board strike Applicant's First through Ninth affirmative defenses.

Respectfully Submitted,

Date: April 30, 2015

By: 

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**CERTIFICATE OF SERVICE**

This will certify that a copy of the foregoing Opposer's Motion to Strike Applicant's Affirmative Defenses has been served upon counsel for Applicant via Federal Express, postage prepaid, on this 30<sup>th</sup> day of April 2015, at the following address of record:

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